

REMARKS

The present reply is in response to the Advisory Action dated February 7, 2007, where the Examiner has maintained the rejection of claims 1 – 13 and 20 – 28, which remain pending in the present application with claims 1, 7, 23, and 24 being the independent claims. Applicant thanks the Examiner for the courteous interview conducted on March 8, 2007. Reconsideration and allowance of pending claims 1 – 13 and 20 – 28 in view of the present amendments and remarks are respectfully requested.

A. Claims 1 – 6, and 20 – 22

During the March 8, 2007 interview, independent claim 1 was discussed with respect to paragraph 2 of the Advisory Action and the Examiner's correct statement that the arguments were directed toward "obtaining profile information from the wireless communication device" while the claim language required "obtaining profile information for the wireless communication device." Applicant has amended independent claim 1 based upon the agreement that the prior art of record does not teach obtaining profile information from the wireless communication device. Applicant hereby incorporates the previous arguments explaining why these claims are allowable in view of the cited prior art.

B. Claims 23 – 28

During the March 8, 2007 interview, independent claims 23 and 24 were discussed. Pursuant to the discussion, Applicant has amended independent claims 23 and 24 to clarify that the first network and the second network are not the same network. Specifically, Applicant has amended each independent claim to require that

the second network is different from the first network. Based on this clarification, Applicant asserts that independent claims 23 and 24 and their respective dependent claims 25 – 28 are presently in condition for allowance. Applicant hereby incorporates the previous arguments explaining why claims 23 – 28 are allowable in view of the cited prior art.

C. Rejection of Claims 7 – 13 Under 35 USC §103

In the Office Action prior to the Advisory Action, claims 7 – 13 were rejected under 35 U.S.C. 103(a) as unpatentable over Shanahan in view of Kamada. That rejection relies primarily on Shanahan as teaching the elements of the claimed invention and states that the combination of Shanahan with Kamada would have been obvious to a person of ordinary skill in the art. This rejection is traversed as follows.

1. Suggestion or Motivation to Combine

As described above, the teachings of Shanahan and Kamada directly oppose each other because Shanahan teaches providing data to a handset while Kamada teaches receiving data from a handset. However, the Office Action states that it would have been obvious to modify Shanahan to include a reserved data storage area “for the purpose of improving upon the limited storage capacity as taught by Kamada in paragraph 001.”

This motivation profoundly fails because the entire focus of Shanahan is to program information into the wireless communication device. Any suggestion that one skilled in the art would somehow be motivated to modify Shanahan such that information was programmed somewhere other than into the wireless communication device is the result of impermissible hindsight. Therefore, one skilled in the art would

not be motivated to combine Shanahan with any teachings from Kamada, whose application is limited by its technical field (see the cited paragraph 001) to portable data terminals with limited internal storage capacity.

Because the Office Action itself has not cited proper motivation taught by the references themselves to combine the diverse systems of Shanahan and Kamada, Applicant respectfully submits that the cited prior art is only modified in retrospect, in light of the claimed invention that the only logical connection between the references is that they both contemplate the moving data over a wireless network. Accordingly, because the obviousness rejection is based upon the Applicant's own invention characterization, and not any properly motivated modification of Shanahan, the rejection fails to make a *prima facie* case for obviousness of independent claim 7.

2. Reasonable Expectation of Success

The Examiner has not demonstrated that the modification of Shanahan by the opposite teachings from Kamada points to the reasonable expectation of success in independent claim 7, which is the second requirement of the obviousness analysis. To modify Shanahan as suggested in the Office Action would require a fundamental change in the basic operation of Shanahan.

3. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of independent claim 7. Specifically, claim 7 requires that the utility programs are executed on the wireless connectivity toolkit server and that the wireless communication device is allowed access to upload and download files to and from a portion of the data storage area on the wireless connectivity toolkit server that is reserved for the wireless communication device.

Neither Shanahan nor Kamada teach these limitations. Importantly, in Kamada, the server apparatus remains in control of the server based storage. Kamada teaches that the server routes files obtained by a user of the handset to a server based storage area. The handset in Kamada is not allowed upload access to this storage area. Kamada teaches that only the server accesses this storage area, which is used to temporarily house files until they expire. This does not teach the claimed invention.

Summary

In summary, the Office Action cites no proper motivation to modify the teachings of Shanahan with the opposite teachings of Kamada. Further, the Examiner has not demonstrated that the modification of the cited the prior art reference points to the reasonable expectation of success in arriving at the elements of independent claim 7, which is the second requirement of the obviousness analysis. Finally, the combination of Shanahan and Kamada fail to teach each and every element of independent claim 7. Thus, the combination of Shanahan with Kamada fails to make the claimed invention obvious and Applicant respectfully requests that the rejection of independent claim 7, and its respective dependent claims be withdrawn and a notice of allowance be issued.

D. Claim 22

In the Office Action prior to the Advisory Action, claim 22 was rejected under 35 U.S.C. 103(a) as unpatentable over Shanahan in view of Kamada in further view of Landis and in further view of U.S. Publication No. 2001/0053708 ("Sugiyama"). The rejection states that the addition of Sugiyama would have been obvious to a person of ordinary skill in the art. This rejection is traversed as follows.

1. Suggestion or Motivation to Combine

Paragraph 007 of Sugiyama is cited as providing one skilled in the art with motivation to combine Sugiyama with the other cited references "for the purpose of simplifying operations." The cited passage from Sugiyama provides no such motivation. The cited passage merely states:

[0007] In addition, some of such portable telephones each has execution keys dedicated to additional functions which are supposed to be often used, for example, an incoming-call sound silencing function, and executes the additional functions in response to pushing of the execution keys. However, it is not sure that all users often use the additional functions, which deteriorates the operability.

Additionally, requiring the compressing and uncompressing the menu of utilities as required by claim 22 does not simplify operations. It makes operations more complicated both on the server and on the wireless communication device. Accordingly the cited motivation fails.

2. Reasonable Expectation of Success

Further, the Examiner has not demonstrated that the modification of the cited the prior art reference points to the reasonable expectation of success in the claimed invention in claim 22, which is the second requirement of the obviousness analysis. As previously stated, to modify Shanahan as suggested in the Office Action with respect to independent claim 1 (from which claim 22 depends) would require a fundamental change in the basic operation of Shanahan.

3. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of claim 22, for the reasons set forth with

respect to claim 1 and also because Sugiyama does not teach the limitations in claim 22. Paragraphs 0008 – 0012 are cited as teaching the step of compressing the menu of available connectivity toolkit utilities, wherein the menu is uncompressed by the wireless communication device prior to being displayed. However, a close review of these paragraphs reveals that Sugiyama nowhere even discusses compression. The cited paragraphs state:

[0008] In view of the foregoing, an object of this invention is to provide a portable telephone which can execute a desired function with simple operations.

[0009] The foregoing object and other objects of the invention have been achieved by the provision of a portable telephone which can execute a function selected from hierarchically structured menus, comprises execution keys for instructing to execute functions, a function assigning means for assigning a desired function to an execution key, and a function executing means for executing a function assigned to an execution key.

[0010] Functions selected by a user from hierarchically structured menus are assigned to dedicated execution keys and the functions, which are assigned to the execution keys, are executed in response to the pressing of the execution keys, so that the functions can be executed with simple operations, regardless of the hierarchies which the functions are belong to.

[0011] Further, in the present invention, execution keys are provided next to a display means for displaying various information, and symbols representing the functions assigned to the execution keys are displayed next to the execution keys, which allows a user to easily and correctly recognize the functions assigned to the execution keys.

[0012] The nature, principle and utility of the invention will become mode apparent from the following detailed description when read in conjunction with the accompanying drawings in which like parts are designated by like reference numerals or characters.

Nowhere in these cited paragraphs does Sugiyama discuss compression.

Accordingly, Sugiyama fails to teach the required compression and claim 22 is in condition for allowance.

Summary

In summary, the rejection fails because it does not cite any proper motivation for combining Sugiyama with the other cited references, it does not demonstrate that the combination of Sugiyama with the other cited references points to the reasonable expectation of success in claim 22, and the combination of references fails to teach each and every element of claim 22. Thus, the Office Action fails to establish a *prima facie* case of obviousness for claim 22 and Applicant respectfully requests that the rejection be withdrawn.

E. Conclusion

For all the foregoing reasons, a notice of allowance directed to claims 1-13 and 20-28 is respectfully requested. If necessary, applicant requests, under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above-identified application and to charge the fees for a large entity under 37 CFR 1.17(a). The Director is authorized to charge any additional fee(s) or any underpayment of fee(s) or credit any overpayment(s) to Deposit Account No. 50-3001 of Kyocera Wireless Corp.

Respectfully Submitted,

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